

REMARKS

Claims 21-38 are pending in the present application. Claims 1, 27, and 33 are amended. Claims 39-41 are added. Support for the amendments may be found at least page 8, lines 17-18, and page 9, lines 1-17 of the present specification. Reconsideration of the claims is respectfully requested.

I. Application to be Considered Special

This application has been pending for over five years and has received a third non-final Office Action after the Request for Continued Examination. As per MPEP § 707.02, Applicants respectfully request that the Supervisory Patent Examiner personally check on the pendency of this application and make every effort to terminate prosecution.

II. 35 U.S.C. § 102, Anticipation

The examiner has rejected claims 21-38 under 35 U.S.C. § 102 as being anticipated by *Williams et al.* (U.S. Patent No. 5,815,657). This rejection is respectfully traversed.

With respect to claims 21, 27, and 33, the Office Action states:

As per claims 21, 27, and 33, Williams teaches a method, an apparatus, and a computer program product in a computer-readable medium for communicating over Internet (see col. 9, lines 30-32) comprising: responsive to receipt of a signal to transmit information from the Internet processor (see col. 8, lines 7-13) over an established Internet connection, identifying at least one information element within the information to be transmitted (see Fig. 10; Fig. 21; and col. 11, lines 5-10, 24-30 & 53-63); generating a message (see col. 11, line 6: "browser launches" and col. 13, lines 31-36: "GUI components for wallet creation"), wherein the message presents the at least one information element (see col. 12, lines 35-40; col. 14, line 62 – col. 15, line 4; and col. 21, lines 25-32) and includes a cancel control (see Fig. 10, #1010; Fig. 11 #1150; Fig. 15, #1595; Fig. 16, #1695; Fig. 17, #1746) for canceling transmission (see col. 2, line 66 – col. 3, line 7); and responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection (see Fig. 13 and col. 31, lines 18-20).

Office Action, dated May 14, 2004. *Williams* teaches a system, method, and article of manufacture for network electronic authorization utilizing an authorization instrument.

An electronic monetary system provides for transactions utilizing an electronic-monetary system that emulates a wallet or purse that is customarily used for keeping money, credit cards, and other forms of payment organized. A user may select an instrument to use for payment and approve the transaction. The instruments in the electronic monetary system are protected by password. Electronic approval results in the generation of an electronic transaction to complete the order. See *Williams*, Abstract. The user may cancel the transaction; however, this cancellation aborts the generation of the information that makes up the transaction. Cancellation of a transaction is not responsive to information being ready for transmission.

In contradistinction, the present invention provides a method, apparatus, and computer program product for allowing a user to determine whether to cancel transmission of itemized information elements in response to the information being automatically created by a process resident on the Internet processor. Claim 21, as amended, recites:

21. A method, in an Internet processor, for communicating over the Internet, the method comprising:
 - responsive to receipt of a signal to transmit information created automatically by a process resident on the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted;
 - generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission, so that a user can determine whether the message should be sent; and
 - responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection.

Thus, the present invention responds to a signal to transmit information that is created automatically by a process resident on the Internet processor and identifies at least one information element in the information to be transmitted. The present invention also generates a message that allows a user to determine whether the message should be sent.

Williams presents a graphical user interface that allows the user to select any instrument in the monetary system and to approve a transaction. In other words, the graphical user interface of *Williams* allows a user to generate information to be transmitted for a transaction; however, once the information is generated, the information

is transmitted and the transaction is completed. Thus, in *Williams*, the cancel controls in Figs. 10 and 11, for example, are used to cancel generation of a transaction. Information is not ready to be transmitted until the transaction is approved and, once the transaction is approved, the transmission cannot be canceled.

Furthermore, *Williams* does not disclose that information to be transmitted is automatically created by a process on the Internet processor. In the present invention, the user is alerted to information of which the user would otherwise have no knowledge. For example, a browser may be about to send sensitive financial information over an Internet connection without the user being privy to the transmission. *Williams* does not recognize this problem. Rather, *Williams* teaches that the user deliberately generates the information through the graphical user interface. Therefore, Applicants submit that *Williams* does not teach or suggest at least identifying at least one information element within information to be transmitted so that a user can determine whether the message should be sent in response to receipt of a signal to transmit information created automatically by a process resident on the Internet processor, as recited in claim 21. The applied reference fails to teach or suggest each and every claim limitation; therefore, *Williams* does not anticipate claim 21. Independent claims 27 and 33, as well as new claims 39-41, recite subject matter addressed above with respect to claim 21 and are allowable for the same reasons. Since claims 22-26, 28-32, and 34-38 depend from claims 21, 27, and 33, the same distinctions between *Williams* and the invention recited in claims 21, 27, and 33 apply for these claims. Additionally, claims 22-26, 28-32, and 34-38 recite other additional combinations of features not suggested by the reference.

More particularly, with respect to claims 24, 25, 30, 31, 36, and 37, the Office Action states:

As per claims 24, 25, 30, 31, 36, and 37, *Williams* teach of further comprising: responsive to deselection of a selection control (see col. 22, lines 32-36), blocking transmission of the information element corresponding to the selection or deselection control (see col. 38, line 6-12: only what has been selected is transmitted). **Note:** what is transmitted and not transmitted resulted by selection or deselection is a matter of programming. This limitation is subjective and does not patentably distinguish the claimed invention. *Williams* clearly teaches of enabling the user to choose what is transmitted and what is not.

Office Action, dated May 14, 2004. Applicants respectfully disagree. Claims 24, 25, 30, 31, 36, and 37 recite blocking transmission of an information element that is within information that is ready to be transmitted. *Williams* merely teaches that a user may not select information that is not to be included when generating information. However, in *Williams* the information is not ready to be transmitted at the time of the selection. Therefore, *Williams* fails to teach or suggest blocking transmission of an information element within information that is ready to be transmitted, as recited in claims 24, 25, 30, 31, 36, and 37. The applied reference fails to teach or suggest each and every claim limitation; therefore, *Williams* does not anticipate claims 24, 25, 30, 31, 36, and 37.

With respect to claims 26, 32, and 38, the Office Action states:

As per claims 26, 32, and 38, *Williams* further teaches wherein the message presents the address of the Internet server to which the information is to be transmitted (see col. 13, lines 45-47: "merchant URL").

Office Action, dated May 14, 2004. Applicants respectfully disagree. The cited portion of *Williams* states:

The Payment Manager 306 coordinates and completes the payment request that is received from the merchant system. The payment request is received via a MIME message in the native code implementation or via an applet in the Java implementation. The payment request received contains the final GSO, Ship-To name, merchant certificate, merchant URL, coupons and the payment amount. The manager 306 then communicates with the payment related GUI component to interact with the consumer to authorize and complete the payment transaction. The manager is also responsible for determining the payment protocol based on the consumer's payment instrument and the merchant's preferred payment protocol.

Williams, col. 13, lines 41-53. While *Williams* does mention the term "merchant URL," the merchant URL is included in a payment request that is received in a MIME message. *Williams* does not teach including an address in a message that presents the at least one information element and includes a cancel control for canceling transmission, as recited in claim 1 on which claim 26 depends. It is important to show the destination of the information, because a user may not want certain information to be sent to a particular

address. The MIME message of *Williams* is not displayed to the user and, thus, does not fulfill the function recited in the claims. For the above reasons, *Williams* does not anticipate claim 26. Claims 32 and 38 recite subject matter addressed above with respect to claim 26 and are allowable for the same reasons.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 21-38 under 35 U.S.C. § 102.

Furthermore, *Williams* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Williams* actually teaches away from the presently claimed invention because it teaches a transmitting whatever information is necessary to complete a transaction, as opposed to identifying potentially sensitive information elements and generating a message with a cancel control, as in the presently claimed invention. Absent the Office Action pointing out some teaching or incentive to implement *Williams* to allow a user to cancel transmission when information is ready to be transmitted, one of ordinary skill in the art would not be led to modify *Williams* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Williams* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.


III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 13, 2004

Respectfully submitted,



Stephen R. Tkacs
Reg. No. 46,430
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 367-2001
Agent for Applicants